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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,215	04/12/2004	David S. Rathbun	001227/0129	1597
69095 7590 04/16/2008 STROOCK & STROOCK & LAVAN, LLP 180 MAIDEN LANE NEW YORK, NY 10038				
EXAMINER COMSTOCK, DAVID C				
ART UNIT 3733		PAPER NUMBER		
MAIL DATE 04/16/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/823,215

**Applicant(s)**

RATHBUN ET AL.

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-12, 19-44, 46-48 and 58-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12, 19-44, 46-48 and 58-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claims 7-12, 19-44, 46-48 and 58-63 is withdrawn in view of the newly discovered reference to Irie et al. (6,471,711) and rejection over Foley (US 2004/0092947). Accordingly, the finality of the last Office action is also withdrawn. Rejections based on the newly cited reference and newly discovered rejection follow.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19-24, 31, 32 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Irie et al. (6,471,711).

Irie et al. disclose the claimed invention including a guide barrel 12 and an alignment assembly comprising a location post 18 and a housing 17 comprising an axial bore. See, e.g., Figs. 7, 9 and 14 and col. 10, lines 17-34. The housing slidably and pivotably receives the location post. The guide barrel is not pivotable relative to the

alignment assembly and is monolithic therewith. The guide barrel can be rather large (col. 10, lines 32-34). The guide barrel is capable of receiving a bone tool capable of forming a cavity in bone (e.g., a tool such as a drill bit or a needle capable of forming a cavity in bone such as spongy and/or compact bone). The guide barrel and alignment assembly have different lengths. The device is capable of being placed on a bone plate and of being used in the intended manner, as conveyed by the claims. The outside of the housing 17 and/or the support portion 23 can be considered a handle since, for example, it is of an appropriate size to be capable of being gripped by hand. The support portion 23 is perpendicular to longitudinal axis of the guide barrel bore.

Claims 37-44 and 46-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Foley (US 2004/0092947; of record).

Foley discloses the claimed invention including a guide barrel, e.g. element 26 and an alignment assembly, e.g. element 66, comprising a location post, e.g. 68. The device is receivable in a bone plate 130. The device is capable of satisfying the claimed intended use. See, e.g., Figs. 3 and 4 and paragraphs 0003 and 0004.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-12, 25-30, 33-35 and 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irie et al. (6,471,711).

Irie et al. disclose the claimed invention except for explicitly disclosing that the adjustment means for the alignment assembly can be a spring. However, the disclosed means and springs are functionally equivalent structures for providing adjustability that are known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted a spring for the adjustment means of Irie et al. as this merely involves the substitution of functionally equivalent structures. A person of ordinary skill in the art would consider springs on a short list of solutions to provide adjustability. Regarding the angle of the barrel with respect to the alignment assembly, it would have been obvious to have provided any desired angle or range of angles, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. It also would have been obvious to have made the device or portions thereof adjustable (including for example the member 23), since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954). Adjustability provides more configurations to increase utility for different physical and other requirements.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DC/

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733